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No. 20267

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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SANTA ANITA MANUFACTURING CORPORATION,

*Appellant and Cross-Appellee,*

*vs.*

MAX J. LUGASH AND MAXON INDUSTRIES, INC.,

*Appellees and Cross-Appellants.*

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Reply Brief of Cross-Appellants Max J. Lugash  
and Maxon Industries, Inc.

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**Reply Brief of Cross-Appellants Max J. Lugash  
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The defendant's answering brief on this cross-appeal (hereinafter cited as "XAB") avoids the central contentions of plaintiffs' opening brief (cited as "XOB"). In addition, the defendant's brief misstates the record at a number of places, which are in need of correction.

I.

**Defendant's Brief Demonstrates the Error of Applying Intricate Metal v. Schneider to Lugash '196.**

Defendant does not question the factual accuracy of the "concise statement of the case" in plaintiffs' opening brief but says that the references to the generic Lugash '227 patent "are irrelevant" to the cross-appeal on the Lugash improvement patent '196. Defendant prepared Findings 31-35(a) regarding the second Lugash patent,

which specifically refer to the first Lugash patent. Defendant itself in its answering brief on the cross-appeal makes frequent references to the first Lugash patent (*e.g.*, XAB 3-5, 15, 30).

An issue in this case is whether the trial court improperly extended the rule of *Intricate Metal Products v. Schneider*, 324 F. 2d 555. As contended by plaintiffs (XOB 22-30) it is essential to distinguish between the claimed subject matter of the Lugash generic patent '227 and the disclosures of the generic patent which are not claimed therein and which are nowhere else to be found in prior art. *Intricate* says it must be done, as was done by plaintiffs in their statement of the case (XOB 6-7). It is relevant.

Finding 34 [R. 671] says that Lugash '227 claims "the folding concept", and that folding is "therefore not of patentable significance in patent '196," which is error. Both patents claim *combinations*, one of whose elements is the invertible platform, which element is material to both combinations. The presence of this element in both combinations cannot detract from patentability of the later filed Lugash '196 (XOB 28-30). *O'Reilly v. Morse*, 15 How. 62, 122.

The Examiner in the Patent Office rightly understood the rule misapplied by the trial court. He repeatedly distinguished between "the claimed subject matter" of Lugash '227 and the *combinations* sought to be claimed in '196 [Ex. B, pp. 20, 24]. Then, when the claims sought in '196 were amended to define the new manner of combining the elements in a new manner of coaction, the combination claims were allowed [Ex. B, pp. 26, 29].



II.

The Patent Office Examiner in Considering the Claims of the '196 Patent, Had the Best Prior Art Before Him in Citing Lugash '227.\*

Lugash '196 claims a unitary invertible platform loader. Lugash '227 claims an invertible platform loader broadly summarized as the combination of parallel linkage systems and invertible platform. Defendant's expert said of the generic Lugash '227 patent, "I think the *basic* parts are attached as a unit" [Tr. p. 833]. None of the claims of Lugash '227 claim a unitary assembly, although defendant's patent expert thought that '227 "is very clearly pointing the way there" [Tr. p. 834].

*Intricate Metal*, as properly understood, makes it clear that to the extent Lugash '227 specification was pointing the way to the unitary invertible platform loader claimed only in Lugash '196, the second patent includes in its claims unpatented disclosures of Lugash '227 not shown by any prior art. Defendant's patent expert admitted that no prior patent was addressed to the objective of a unitary invertible platform loader and no prior patentee had elements combined in the manner to make such a loader [Tr. p. 823, lines 10-15; Tr. p. 825, line 9, to p. 826, line 6].

In attempting to deal with the *Intricate Metal* case, defendant's brief unconsciously strengthens plaintiffs' contention that the actually claimed subject matter of Lugash '227 constitutes the best prior art against Lugash '196. Thus the non-cited prior art relied on by

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\*At page 32 of our opening brief, we quote testimony by defendant's patent expert and describe it as being in response to his own counsel's questioning. Actually, the quoted testimony was on *cross-examination* by plaintiffs' counsel and was therefore presented less forcefully than it could have been.

defendant is valueless as a basis for rebutting the presumption of validity of '196. It has never been plaintiffs' position that the element of a frame structure constitutes "the additional element providing a new unitary combination in Lugash '196" as defendant's brief says (XAB 30). However, this misrepresentation of plaintiffs' position substantiates plaintiffs' contention that the *claimed* subject matter of Lugash '227 was the best possible pertinent art on which the Examiner could have relied, as he did.

A "frame structure" is one element of the combination of claim 5 of Lugash '227 (which is not in suit). Clearly, this claimed subject matter constitutes far more pertinent prior art than the unitary tailgate structures relied on by defendant.

### III.

#### **Defendant's Brief Promises, but Does Not Deliver, References to Evidence in the Record in Support of Findings 34-35(a) (XAB 30).**

Logic dictates that a finding of fact is "clearly erroneous" when the record is totally barren of any evidence in support of what is stated in the finding. Now Lugash '196 claims a combination of elements, one of which is an invertible platform. Not one of the tailgate items of prior art mentioned in Finding 35 has a scintilla of a suggestion of such element and at the trial, defendant did not introduce any such testimony or claim on behalf of the tailgates mentioned in Finding 35. The finding having thus been challenged, Rule 18(3) of this court requires defendant's brief to "contain record references to the evidence relied upon by appellees as supporting the challenged finding." Defendant's brief does not mention any such record references and we think there are none.

As we have shown, (XOB 22-24), only Lugash '196 has the vital disclosure of a manner of unitary arrangement of the parts for operative clearance therebetween for stowing a platform loader. Finding 34 claims such disclosure on behalf of prior art tailgates. Defendant's *only* evidence, regarding Lugash's *claimed* combination, was with reference to a *tailgate* loader having a notch in the wrong edge of the platform for totally different purposes. This evidence was so summarized in plaintiffs' opening brief (XOB 23, 24) and defendant's brief does not even deal with it.

With respect to plaintiffs' Specification of Error 5, defendant's brief nowhere contests the fact that Lugash '196 for the first time discloses and gives the art a unitary invertible platform loader. With respect to plaintiffs' Specification of Error 6, defendant's brief nowhere contests the portions asserting that only the unitary invertible platform loader of Lugash '196 eliminates problems of both preserving the operating alignment of its own parts and the problem of mating alignment of a load platform with specially cut openings in the floor or side wall, or both, of a truck or vehicle. Defendant's failure to contest these matters demonstrates that the trial court did not accurately and fully summarize the advance of Lugash '196 over the prior art.

#### IV.

**Defendant Cannot Limit Lugash to His Filing Date for His '196 Patent, i.e., September 27, 1957.**

Defendant makes this attempt in order to rely on its EB 1200 and EB 1500 as prior art unitary tailgate loaders (XAB 20), first sold in July 1957 [Ex. 6—Answer to Interrogatory 7(e)].

The fact is, that plaintiffs' Tuk-Away loader under the '196 patent was manufactured and sold *prior to* defendant's EB 1200 and EB 1500 tailgate loaders. At page 14 of its opening brief on the main appeal, defendant alleges [without proof and contrary to Finding 9] that there were no successful commercial embodiments of the '227 patent. Defendant there says that it was only the commercial loader of the '196 patent which was commercially successful, and that loader of Lugash was first sold at least as early as April 26, 1957 [Ex. AU—Answers to Interrogatories 4 and 7], two to three months before defendant's 1200 and 1500 tailgate loaders.

Defendant goes on to allege certain acts done in converting its 1200 and 1500 tailgate loaders to the infringing Folda-Lift (XAB 20, 21). The Patent Act tells us (35 U.S.C. 103) that the non-obviousness of an invention is to be determined as of the date the invention was made. The evidence shows that Lugash's unitary invertible platform loader invention was made at least by April 26, 1957 and, conclusively, no later than September 27, 1957, but the defendant in this part of its brief talks *only* of acts performed subsequent to Lugash's filing date. Obviously, the legislative fiat makes such evidence totally unacceptable for this purpose.

## V.

**Defendant Now Attacks as "Mere Verbiage" a Result Which Lugash '196 Explicitly States and Which Defendant Didn't Even Contest at the Trial.**

In constructing this new argument, defendant cites portions of the record which are not directed to the point.

Defendant says that “plaintiffs are required to advise this court exactly what the purported invention of the second Lugash patent ’196 is” (XAB 10). Plaintiffs, in their brief, repeatedly and exactly summarized Lugash ’196 as a unitary invertible platform loader attachable as a unit to any desired location under a truck. Defendant deletes the invertible platform from Lugash’s combination, which is precisely one of the errors of Finding 34 [R. 671].

The difference between plaintiffs’ definition of the Lugash ’196 invention and defendant’s résumé of it is this—Lugash ’196 claims a *combination* of elements, one of which is an invertible platform, arranged with clearance for the several parts “to swing said linkage means upwardly . . . with consequent elevation . . . of the inverted platform to a position beneath the vehicle bed” [Lugash ’196—Ex. 2—Claim 1]. Lugash’s ’196 patent is directed to a unitary stowable loader “which can be applied to a truck in any desired location”—“whether the hoist is mounted on the end or side of the vehicle” [Ex. 2, Col. 4, lines 34-37 and Col. 4, lines 41-52].

Is this “mere verbiage”? Although defendant now says so, it advertises its unitary infringing device as, “Ideal for unusual requirements such as mounting on side of body” [Ex. 4]. Truckers do not buy “verbiage.”

The practical significance of the new result of Lugash ’196—the extent to which it is ideal for unusual requirements—is very well brought out by defendant’s reference to its Exhibits EG and AC [defendant admitted that Ex. EG is “obviously” not prior art Tr. p. 402].

First, Exhibit EG, page 5, shows a tailgate adapted to special use as a side loader on a school bus. Obviously, (1) that loader is not an attachment—(2) there



is a problem in mounting that loader in operative alignment with a special cut-out in the floor of the bus and, also, with the double door of the bus. And so we see the merit of plaintiffs' Specification of Error 6, which points out that Lugash '196 for the first time provides a unitary power loader attachable at any desired location under a truck and which eliminates the problems of alignment obviously inherent in the device relied on by defendant, which device cannot be stowed at all.

Defendant also refers to Exhibit AC, page 4, showing two tailgate loaders mounted as side loaders on a semi-trailer. There is no evidence in the record that these side mounted tailgate loaders are unitary, as argued by defendant. There is no evidence in the record of what, if anything, happens to the load platforms when the device is not being used for loading and certainly no evidence that they can be stowed under the bed of the truck.

Lugash in his '196 patent has taken all of the elements of a power loader and arranged them into a unitary assembly that can be folded into a compact stowed loader so that when not in use, the whole is out of the way under the bed of the truck, at any position under the truck. This is a substantial accomplishment. The patent of defendant's president points out the problems of attaching mere liftgate loaders in the "severely limited space" under vehicle bodies, to paraphrase him [Ex. C—Vogel '554, Col. 1, lines 22-27]. Vogel has such a fear of this severely limited space that in his '554 patent, he puts practically none of the parts of his tailgate loader under the truck bed—note how his main frame, lifting arms, platform and power means *all* protrude beyond the end of the truck bed.

Nor is Vogel alone in avoiding the environment of severely limited space which Lugash attacked. Messick says of his unitary tailgate that it “mounts all parts of the invention directly at the rear of the truck where they are readily accessible. No parts extend forwardly under the truck to inaccessible places” [Ex. C, Messick, Col. 3, lines 78-81]. Defendant also relies heavily on Wood ’540, who puts *none* of his parts under the truck bed. Wood says of his unitary tailgate that “it is attached to and mounted upon the open and unencumbered rear end of the truck body with no need to rely upon the chassis or engine environment or cab of the truck” [Ex. C, Wood ’540, Col. 3, lines 9-12].

## VI.

**Lugash’s ’196 Patent Claims a Manner of Arranging the Elements of the Combination With Clearance for Operation of the Parts for Both Loading and Stowing Purposes.**

Plaintiffs are charged with “the complete fabrication of a problem of clearance” (XAB 14). We submit it does not constitute “fabrication” to merely quote or paraphrase the language used in an exchange between defense counsel and his patent expert. *They* conclusively established that if one is going to fold a large platform, a pair of linkage systems and the hydraulic cylinder into the same limited space, there is a problem of arranging the parts in a manner to allow them to operate. They said it was a “problem”. The language did not originate with plaintiffs.

“Q. Now, in the ’196 patent, when Lugash decided to move the hydraulic cylinder in the middle between his arms into a substantially vertical position, was he faced with a problem when he folded his platform? A. Yes.” [Tr. p. 658, lines 9-18].

Defendant quotes plaintiffs' patent expert, out of context, as support for defendant's fallacious proposition. After quoting Mr. Comstock as saying, "That is right" (XAB 3), they delete the rest of his answer in which he made it plain that mere frictional engagement between an inverted platform and hydraulic cylinder casing is insignificant, rather than significant, as regards operating clearance of the parts. [Tr. p. 252, line 23, to p. 253, line 5].

Claims 1, 2 and 4 of Lugash '196 claim, relatively broadly, the manner of arrangement of the parts to achieve the requisite clearance function for operating in both loading and stowing operations. Of the claims in suit, only claim 5, which is dependent on claim 4, puts any specific structural definition on one of the parts for the clearance arrangement already defined in claim 4, *i.e.*, "a recess affording clearance for said piston and cylinder when said platform is disposed in said inverted position".\*

Defendant erroneously attempts to restrict all of the claims in suit to the specific recess of claim 5. This cannot be done, as is well brought out by *Stearns v. Tinker & Rasor*, 252 F. 2d 589, 597.

In so concentrating on mere slots, rather than dealing with Lugash's claimed arrangement of the parts for clearance, defendant concentrates its attack only on the validity of claim 5. The trouble with this approach of defendant, even as applied to claim 5 only, is that there is no evidence of record which could reasonably support its position. The best defendant could do in this respect

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\*Notwithstanding defendant's assertion (without record citation) to the contrary, some models of the infringing Folda-Lift were proved to have the clearance recess, as in claim 5 [Ex. E, pp. 98, 139].



was to point to a prior tailgate loader having a notch in the wrong edge of the platform for the wrong purpose as was pointed out in our opening brief (XOB 23).

Defendant's brief asserts "inverting of the platform and raising of the lifting arms in any of the Novotney '403, Narvestad '529 (Figs. 5-7) or Jester '243 patents would not interfere with operation of the power means" (XAB 16). Defendant cites no record in support of this allegation. Defendant's statement attributes to Jester a possibility which Jester himself specifically prohibits [Ex. D, Jester, Col. 1, lines 12-17, page 2, Col. 2, lines 15-21]. With regard to Narvestad [Ex. C], defendant's expert admitted that the power means has no function in sliding the platform in and out of a stowed position [Tr. p. 801, lines 4-6]. A merely cursory examination of Novotney '403, Narvestad and Jester reveals that none of them is of a unitary construction and none of them teaches a unitary invertible platform loader [Tr. p. 825, line 9, to p. 826, line 6; Tr. p. 823, lines 10-15].

## VII.

### The Claimed Subject Matter of Lugash '196 Is the Entirety of the Combination.

"If anything is settled in the Patent Law, it is that the combination patent covers only the totality of the elements in the claim . . ." *ARO v. Convertible Top*, 365 U.S. 336, 344. To subtract an element from a combination claim is not permissible. *Fay v. Cordesman*, 109 U.S. 408, 421. Contrary to these principles, defendant asks the court to test the validity of the Lugash '196 claims by reading out of them the invertible platform element.

Defendant thus attempts to reduce Lugash's claimed combination, including the invertible platform element, to merely a unitary structure without any invertible platform or clearance arrangement, for purposes of a specious reliance on *Graham v. John Deere*, 86 S. Ct. 684. The trouble with this gambit is that the immutable facts of the file history and controlling rules of law do not permit such a result.

The distinguishing feature of Lugash's combination is neither a unitary construction *per se* nor an invertible platform *per se*. As is plain from a reading of the claims, considered in the light of the specification and file history, Lugash's invention, as a whole, is a unitary loader with an invertible platform and with this unitary assembly having the parts arranged with the power means "connected to said linkage means at a point thereon affording clearance for movement of said platform to said inverted position . . ." and "operable to swing said linkage means upwardly about said pivotal connection with said main frame member with consequent elevation . . . of the inverted platform to a position beneath the vehicle bed" [Ex. 2, Lugash '196, claim 1]. The distinction of Lugash '196 is the combination, not the individual or several elements, and certainly not unitary construction, broadly speaking.

Defendant argues that "a myriad of old elements . . . were *added* to the claims in order to obtain the issuance of this patent" (XAB 9). This is not an accurate statement in any respect. That "myriad of old elements" was present in application claim 6 as filed [Ex. B, p. 10] and allowed as claim 4, after amendment in other respects [Ex. B, p. 21].

Defendant's position is additionally factually wrong because it attempts to lead the court to a conclusion that it was only because of the addition of the "myriad of old elements" that claims were allowed to Lugash. That is not so. The Examiner twice rejected Lugash's claims when they included these elements but did not define the arrangement of the elements for operative clearance in carrying out their function [Ex. B, pp. 17-24].

Clearly, what caused the Examiner to allow claims was the argument made in the last amendment that they had been amended "to bring out the fact that the supporting and lifting linkage and the platform, as well as the lifting means are all arranged so that the platform can be swung to an inverted position upon the lifting linkage" [Ex. B, p. 26]. It was this novel combining of the parts, recited in the claims, which the Patent Office Examiner could not find in the prior art and which is not in any prior art.

### VIII.

#### **Prior Concepts Do Not Anticipate Subsequent Devices, Which Is the Gist of Defendant's Argument.**

Because there were prior unitary tailgates, defendant contends "There can be no patentable invention in forming a unitized assembly" (XAB 12). This court in *International v. Landon*, 336 F. 2d 723 held valid two patents on unitary construction, despite prior art unitary devices.

The most that can be said for defendant's argument is that defendant has shown that there was in the prior art the same catalog of elements as Lugash '196. The findings, when fairly read in the light of the court's

opinion, go no further than that, which this court has held to be insufficient in saying "The invalidity of a combination patent is not established by showing only that there was, in the prior art, a device containing the same elements". *International Manufacturing Co. v. Landon, Inc.*, *supra*, at 336 F. 2d 726. It never has been the law that a combination patent is invalidated merely by showing that a relevant concept was in the prior art. Obviously the first tailgate patent in this record, Ducondu '473, does not invalidate all subsequent tailgate loader patents. Yet, this is the rationale of defendant in its brief, in arguing that prior unitary tailgate loaders or patents are, without more, sufficient to invalidate Lugash's claimed unitary invertible platform loader.

Being obsessed with the tailgate idea, the prior unitary patentees were not even aware of the existence of the clearance problem involved in Lugash's loader and, therefore, as might be expected, defendant has not been able to prove that any prior patentee, consciously or unconsciously, devised the specific arrangement of parts claimed by Lugash in his '196 patent.

## IX.

**Plaintiffs' Contention — That Lugash's Admittedly Novel Combination, Productive of New and Useful Results, Entitles Him to His '196 Patent Under Controlling Authority (XOB 30) — Is Completely Avoided by Defendant's Brief.**

Instead, defendant's argument is a contrived attempt to bring this case within the purview of *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147 and *Lincoln Engineering Co. of Illinois v. Stewart-Warner Corp.*, 303 U.S. 545.

Defendant alleges, without any record citation, that “Lugash ’196 claims define an *old* combination” (XAB 23). No finding of fact supports this bare allegation. Although made up of old elements, Lugash’s claims define a *new* combination. Surely this is incontrovertibly established by the admissions of defendant’s patent expert—that no prior patentee shows the combination of an invertible platform and parallel rule linkage systems [Tr. pp. 786, 787], let alone any conception of a unitary invertible platform loader [Tr. p. 823, lines 10-15], and that prior to Lugash ’196 there never was any unitary loader with an invertible platform shown or described [Tr. pp. 825, 826].

This new combination is not subject to the principles stated in *A & P* and *Lincoln* because Lugash is not in the position of one who merely improves one element of a prior combination and then seeks to claim the entire combination, rather than the improvement *per se*. In *A & P*, the court expressly exempted a new combination from the principle applied there, saying:

“... if the extension itself were conceded to be a patentable improvement of the counter, and the claims were construed to include it, the patent would nevertheless be invalid for overclaiming the invention by including old elements, *unless*, together with its other old elements, the extension made up a *new combination* patentable as such” (Emphasis added). 340 U.S. at 150.

*Lincoln* also involved overclaiming, *i.e.*, the patentee improved an element but claimed the entire combination. The principle of *Lincoln* was expressly held not applicable to a new combination in *Williams Manufacturing Co. v. United Shoe Machinery Corp.*, 316 U.S.



364. And so this court was correct and should follow its ruling in *Pursche v. Atlas Scraper and Engineering Co.*, 300 F. 2d 467 at 477, that the principle of *Lincoln* cannot be applied to Lugash's new combination producing new and useful results.

As this court said in *Pursche v. Atlas*, even if every element of the combination remains a unit retaining its own individuality and identity as a complete and operative means, the combination is an entirely new and distinct thing, which new combination is not within the reach of *Lincoln* when that combination, as distinguished from its elements produces a new and useful result, as does Lugash '196.

Defendant's argument ignores the plain meaning of Lugash's claims. The parts cooperate with one another not only for the purposes of loading and stowing but, also, with clearance permitting those two functions within a unitary compact assembly that can be stowed *under* any location on a truck bed. No prior device has that complete organization—let alone the clearance functions of the parts in Lugash's combination.

## X.

**It is Now Clear That the Exclusive Tests of Patentability Are the Three Statutory Conditions of Utility, Novelty and Nonobviousness.**

This is true of all patents—there are no special tests for combination claims that are not comprehended within the statutory scheme. While defendant seeks to impose the condition of promoting “the progress of science” (XAB 41), *Graham v. Deere*, 86 S. Ct. 684 definitively states that the constitutional objective is to advance “the useful arts”, 86 S. Ct. 687, and whether a

patent does so or not is to be determined solely within the framework of the statutory scheme by making basic factual inquiries as to utility, novelty and nonobviousness, 86 S. Ct. 694.

Notwithstanding the attempt of defendant's brief to contest utility and novelty of Lugash '196, the record is clear that the sole issue on this cross-appeal is one of nonobviousness under 35 U.S.C. 103, approached in the light of *Graham v. Deere* and *United States v. Adams*, 86 S. Ct. 708. It is clear that the differences between the prior art and Lugash '196 cannot reasonably be reduced to less than the following, which under the authorities, demonstrate the presence of "invention"—*i.e.*, nonobviousness—of Lugash '196:

A. As distinguished from defendant's rough summation of Lugash '196, the combination actually claimed by Lugash is novel—there is no evidence in the record that any prior art combined the elements in the manner in which they are combined in Lugash's claims.

B. No prior art ever conceived of Lugash's concept of a unitary invertible platform loader attachable at any location under a truck.

C. There is no evidence in the record that any prior worker in the field, even unconsciously, arranged the parts of the loader in the manner claimed by Lugash to achieve the manner of cooperation of these parts to effect a unitary, invertible platform loader.

Defendant treats Lugash '196 as though it covered the same old catalog of elements long used in power loaders, while minimizing differences which it concedes only inferentially. But that is not an attack on the

*claims* of Lugash '196. He does not claim that old catalog of elements. He claims a new combination—of elements arranged in a manner to achieve a compact, unitary invertible platform loader—a specific device which the art never had before.

The structural differences of Lugash '196 over the prior art are spelled out in the claims. But then Defendant minimizes the *quality* of these structural differences, alleging that they are within the capability of a person of ordinary skill in this art. That is beside the point under the facts in *this* case. As has long been recognized by Supreme Court standards, small differences can support a patent and simplicity of structural change does not necessarily mean that the constitutional objective of advancing the useful arts has not been fulfilled. "The emphasis on nonobviousness is one of inquiry, not quality, and, as such, comports with the constitutional strictures". *Graham v. Deere*, 86 S. Ct. 693. This is justly so because "in every case, the idea conceived is the invention." *Gill v. United States*, 160 U.S. 426, 436, and Lugash's guiding conception was totally absent in the prior art.

As we pointed out in our opening brief (XOB 22-24), only Lugash '196 teaches and claims a particular disclosure which is an essential part of his combination. The manner of combining the parts for clearance purposes and the manner of their co-action for clearance for Lugash's particular end was clearly never appreciated by any prior worker in the field. That also is evidence of "invention", *i.e.*, nonobviousness. This was true in the Supreme Court before *Graham v. Deere*, as in *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 361 U.S. 45. Since *Graham v. Deere*, and in the



light of that recent decision, this rule has been applied as dictating nonobviousness in *Gray Company, Inc. v. Speeflow Manufacturing Corp.*, by the Court of Appeals for the Fifth Circuit, 149 U.S. P.Q. 804 at 805.

### Conclusion.

On this record, it cannot reasonably be questioned that Lugash in his '196 patent had an original idea which became embodied in a mechanism which is practical for everyday use by truckers. Once done, how easy it is to look back and say that anybody could have done it. But the law has other tests than such conjecture. The patent statute and any consideration of nonobviousness under 35 U.S.C. 103 requires basic factual inquiries, which are more practical tests of patentability. *Graham v. Deere*, 86 S. Ct. 693, 694. A far more objective indicia of patentability than an infringer's characteristic 20-20 hindsight is defendant's concession that the loader of Lugash's '196 patent has had remarkable commercial success. That is to say, that it is greatly practical for everyday use. Clearly then, a unitary, invertible platform loader has been of some significance in advancing the useful arts—it is "Ideal for the unusual situations" [Ex. 4]. The loader of Lugash '196 works in these unusual situations and this record is totally barren of evidence that any prior device ever foresaw the particular niche in the art created by Lugash '196.

As this court has held, the fact that Lugash '196 "works", on a record having no evidence that any prior device did work for Lugash's purpose is "something" indicating "invention", i.e., non-obviousness. *Twentiers Research, Inc. v. Hollister, Inc.*, 319 F. 2d 898, 902.

This factor is important as an indicator of nonobviousness as the same rationale was applied by the Supreme Court in *United States v. Adams, supra*. Adams' battery worked. It had operating characteristics giving valuable advantages over the non-equivalent prior art relied on there. So, in this case, defendant itself has admitted that the device of Lugash '196 is ideal for unusual situations and there was not in the prior art any equivalent device known for the purpose. It is not obvious and this court should uphold the Lugash '196 patent.

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### **Certificate.**

I certify that in connection with the preparation of this brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those Rules.

ROBERT W. FULWIDER

